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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,163

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Danny A. Grant

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,163	Applicant(s) GRANT ET AL.	
	Examiner Hyun Nam	Art Unit 2184	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10,12,13,26 and 28-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,10,12,13,26 and 28-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/31/2010 has been entered.

Claim Objections - Formality

Claims 10, 12, 13, 33, and 36 are objected to because of the following informalities:

In claims 10, 12, 13, 33, and 36, line 1, 'The computer readable medium' should be '--The non-transient computer readable medium--' to avoid the possible 101 issue.

Appropriate correction is required.

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3-5, 10, 12, 13, 26, and 28-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8-11, 17-23, and 29-31 of copending Application No. 10/538,162, hereinafter Grant '162. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims	Instant	Claims	Grant '162
1, 10, 26, 33, or 34	Generating an output signal to Second from First Signal includes Haptic Code Code Id's First Actuation of member(s) Haptic Effect on Second Code Id's Status Event Hand held Com. Device	4, 11, 18,	Receiving an input signal from Sending Party Signal includes Haptic Code Code/Logo Id's Sender Control Signal on Actuator Haptic Effect on Receiver Logo ID's Status Event Hand held Com. Device

The examiner also recommends sending IDS generated from Instant Application to following copending applications: 10/538,160, 11/226/910, 11/545,739, and 11/226, 915.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 10, 12, 13, 26, and 28-31 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaaresoja et al. (U.S. Publication Number 2002/0177471) hereinafter Kaaresoja '471 'evidenced' or 'in view of' Ronkainen (U.S. Patent 6,850,150) here in after Ronkainen '150.

Art Unit: 2184

Examiner recognizes that, a single rejection under either 35 U.S.C. 102 or 35 U.S.C. 103(a) should be made whenever possible; however, circumstances where 102/103 rejection is appropriate are as follows:

- a. When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate. See MPEP § § 2111-2116.01 for guidelines on claim interpretation.*
- b. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02.*

The Examiner has construed that the claimed limitation 'a haptic code configured to distinctly identify the first handheld communication device and a status event' as a 'caller id' via haptic effect on a phone: 'caller-id' feature identifies 'a caller' and indicates 'a call event' which is a status of the phone. Although, not all the phones inherently have a caller-id feature, the given evidence seems to indicate that a communication device disclosed in Kaaresoja '471 has a caller-id feature. Additionally, evidence seems to indicate that the caller-id feature is implemented with haptic effect. The paragraphs 7-10 in Kaaresoja '471 suggest improving upon the designs of Ronkainen '150. One of the features that are to be improved upon is the caller-id feature (see Kaaresoja '471, Paragraph 9 and see Ronkainen '150 Column 2, Lines 25-40)

Art Unit: 2184

Referring to claim 1, Kaaresoja '471 teaches, as claimed, a method, comprising:

generating an output signal (see Fig. 1, Antenna 102) upon an actuation of one or more of a plurality of user-interface members (a key of keys on keypad, see Fig. 1, Keypad 108 and Paragraph 17, Line 6) on a first handheld communication device (mobile phone, see Paragraph 17, Line 2), wherein the output signal includes a haptic code (see Fig. 1, Control Signal to Vibration Motor 100) and

sending the output signal to a second handheld communication device (mobile phone, see Paragraph 17, Line 2) remote from the first handheld communication device (see Paragraph 24, Lines 9-11; Note, tactile icons composed from one device is sent to another remote device), wherein the output signal causes an output, at the second handheld communication device, of a haptic effect corresponding to the haptic code (haptic effect due to vibration of a motor, see Paragraphs 9 and 11).

Kaaresoja '471 does not disclose expressly a haptic code configured to distinctly identify the first handheld communication device and a status event (i.e. in case where inherency of this feature maybe in dispute).

Art Unit: 2184

Ronkainen '150 does disclose a haptic code configured to distinctly identify the first handheld communication device and a status event (see Column 2, Lines 25-40; Note, the Ronkainen '150 is recited in paragraphs 7-10 of Kaaresoja '471).

At the time of the invention, if not inherent, it would have been obvious to a person of ordinary skill in the art to incorporate Ronkainen '150 into Kaaresoja '471.

The suggestion/motivation for doing so would have been to engage the senses of touching without eliminating essential features of previous designs (see Kaaresoja '471, Paragraphs 10 and 11).

As to claim 3, Kaaresoja '471 teaches, the method of claim 1 wherein sending further includes in the output signal at least one of a message (voice message, see Fig. 1, Loudspeaker 114), a video image (an animation, see Paragraph 18, Line 4), and a graphical feature (pictures, see Paragraph 18, Line 3).

As to claim 4, Kaaresoja '471 teaches, the method of claim 1 wherein the haptic code is associated with a predetermined scheme (see Fig. 1, stored vibration pattern 140e; Note, predetermined vibrations patterns are stored in the memory for later determination of tactile sensation to be sent or received).

Art Unit: 2184

As to claim 5, Kaaresoja '471 teaches, the method of claim 1 wherein receiving further includes defining the one of the user-interface members (see Paragraph 17, Line 6; Note, a menu item is defined to the key in the keypad) include at least one of a key, a button, a key pad (see Fig. 1, Keypad 108), a direction pad, a touch screen, a scroll wheel, a mini-joystick, a trackball, and a knob (Note, the Keypad 108 is one of the user-interface member listed above).

As to claims 10, 12, and 13, they are directed to a computer-readable medium on which is encoded program code to implement the methods as set forth in claims 1, 3, and 4 respectively. Therefore, they are rejected on the same basis as set forth hereinabove.

As to claim 26, it is directed to a handheld communication device to implement the method as set forth in claim 1. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claim 28, Kaaresoja '471 teaches, the handheld communication device of claim 26, wherein the handheld communication device is one of a cellular phone (see Fig. 1, a Block Diagram of a Mobile Phone), a satellite phone, a cordless phone, a personal digital assistant, a pager, a two-way radio, a portable computer, a game console controller, a personal gaming device, and an MP3 player (Note, the mobile phone is one of the device listed above).

Art Unit: 2184

As to claim 29, Kaaresoja '471 teaches, the handheld communication device of claim 26 wherein the plurality of user-interface members includes at least one of a key (a key on keypad, see Fig. 1, Keypad 108), a button, a key pad (see Fig. 1, Keypad 108), a direction pad, a touch screen, a scroll wheel, a mini-joystick, a trackball, and a knob (Note, the Keypad 108 is one of the user-interface member listed above).

As to claims 30, Kaaresoja '471 teaches, the handheld communication device of claim 26 further comprising memory (see Fig. 1, Memory 140), wherein the memory stores program code (see Fig. 1, Vibration pattern interpreter 140a) for extracting a haptic stimuli (see Fig. 2, Vibration patterns) from the input signal.

As to claim 31, Kaaresoja '471 teaches, the handheld communication device of claim 26 further comprising a display device (see Fig. 1, Display 110) in communication with the processor (see Fig. 1, Controller 106), the processor to cause the display device to produce an image of the identified source (pictures, see Paragraph 18, Line 3).

Claims 32-34 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471/Rokainen '150 further in view of Wanderlich (U.S. Patent 6,028,531), hereinafter Wanderlich '531.

As to claims 32, Kaaresoja '471 teaches a method to implement the same method as set forth in claim 1.

Kaaresoja '471 does not expressly disclose a method comprising user-interface member being assigned to a haptic code.

Wanderlich '531 does disclose a switch being assigned to a tone and a vibration (see Fig. 2, Switch 40). Furthermore, Wanderlich '531 disclose numeral 0 thru 9 being assigned to combination of signal amplitude, vibration frequency, and duration (see Column 7, Lines -6-25).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to assign a haptic code or vibration pattern/signal to a switch/keypad on a mobile device of Kaaresoja '471.

The suggestion/motivation for doing so would have been to have convenient access and feel to the most frequently used or favorite vibration pattern.

As to claims 33, it is directed to a program code to implement the method as set forth in claim 32. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claims 34, it is directed to a device to implement the method as set forth in claim 32. Therefore, it is rejected on the same basis as set forth hereinabove.

Art Unit: 2184

Claims 35-37 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471/Rokainen '150 further in view of Epstein et al. (U.S. Publication 2003/0038776), hereinafter Epstein '729 and Amon (U.S. Publication 2002/0107936), hereinafter Amon '936.

Referring to claims 35-37, Kaaresoja '471 teaches, as claimed, a method of claim 1, a computer readable medium of claim 10, and a device of claim 26 respectively.

Kaaresoja '471 does not disclose expressly wherein the status event is selected from the group consisting of an advertisement event, a one-to-one marketing event, a business-transaction event, a stock-trading event, a weather-forecast event, and an emergency event.

Epstein '729 does disclose a wherein the status events consisting of an advertisement event (see Paragraph 14), a one-to-one marketing event (see Paragraph 16), a business-transaction event (see Paragraph 27), and a stock-trading event (exchange, see Title and Fig. 11).

Amon '936 does disclose a weather-forecast event (see Paragraph 16) and an emergency event (see Fig. 6).

Art Unit: 2184

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate status events of Epstein '729 and Amon '936 into Kaaresoja '471.

The suggestion/motivation for doing so would have been to provide most comprehensive mobile PDA and/or Phone services.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471/Rokainen '150 further in view of Fukuhara et al, 'Voice Café: Conversation Support System' hereinafter Fukuhara.

As to claims 38, Kaaresoja '471 teaches a method of claim 1, wherein the output signal is sent during a session (emails and non-verbal stylized message, see Paragraphs 4, 5, and 16) between the first handheld communication device and the second handheld communication device.

Kaaresoja '471 does not disclose expressly a chat session.

Fukuhara does disclose a chat session (Computer Mediated Communication tools, see Page 2) via haptic means.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate chat session into non-verbal sessions of Kaaresoja '471.

Art Unit: 2184

The suggestion/motivation for doing so would have been to broaden the means to share tactile information and engage the sense of touch over the network (see Fukuhara Pages 1-2 and see Kaaresoja '471, Paragraph 10).

As to claim 39, the modification teaches, the method of claim 38, wherein the haptic code (see Fig. 1, Control Signal to Vibration Motor; Note, the Instant Disclosure disclose that 'a haptic code' is extracted from the input signal and 'the extracted haptic code' may be directly applied. Examiner also notes that the output signal of the first device is the input signal of the second device. See figure 3 and paragraph 38 of Instant Application. In a same way, Kaaresoja '471, discloses that 'a control signal' is extracted from input signal of Transceiver 104 via Controller 106) is configured to be directly applied to an actuator (see Fig. 1, Vibration Motor 100) of the second handheld communication device to cause the haptic effect.

Response to Arguments

Applicant's arguments filed 3/22/2010 have been fully considered but they are moot in view of new grounds of rejections (for the explanation of the 102 rejections, see the comments above).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyun Nam whose telephone number is (571) 270-1725 and fax number is (571) 270-2725. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Henry Tsai can be reached on (571) 272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Henry W.H. Tsai/

Supervisory Patent Examiner, Art Unit 2184